REMARKS

1. STATUS OF CLAIMS

The Applicants have filed a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. This paper, entitled "Preliminary Reply," is being filed in response to a final rejection mailed June 14, 2002.

Claims 1-9, 11-17, 19 and 21-27 are currently pending in the application. In the final rejection, each claim was rejected under 35 USC §103(a) as being unpatentable over Altschul et al. (5,983,094 hereinafter Atlschul) in view of Goldhaber et al. (5,855,008 herein after Goldhaber) further in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). No claims have been allowed. The claims are reproduced below in APPENDIX A.

2. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection mailed June 14, 2002.

3. SUMMARY OF INVENTION

The demand for services has increased for wireless communication systems. The cost of these services, however, still remains high for many individual subscribers for many services. There is a need for alternative service offerings of network providers to enable better usage on the wireless communication network. The present invention is directed to satisfying that need.

In particular, independent claim 1 is directed to a method of providing service in a wireless communication network. The steps include: providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network; providing products or services to said end user in response to a subscription to one of said service options; and providing ***advertisements*** to the end user ***in lieu of*** receiving compensation for the subscription, wherein the provision of the

advertisements is based upon a content that a user is receiving on said wireless communication device. [*See, e.g.,* Application, p. 19, lines 1-26; p. 30, line 26 – p. 31, line 6]

Independent claim 13 is similar to claim 1 in that it recites the steps of providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network, providing products or services to said end user in response to a subscription to one of said service options, and providing ***advertisements*** to the end user ***in lieu of*** receiving compensation for the subscription. However, in claim 13, the provision of the advertisements are based upon a configuration of the wireless communication device. [*See, e.g.,* Application, p. 20, lines 10 – p. 22, line 23]

Independent claim 27 is similar to claim 13 and is directed to a method where the wireless communication device is in a vehicle. The method includes, among other things, the step of providing advertisements to the end user in lieu of receiving compensation wherein the advertisements are based upon the status of sensors in a vehicle incorporating the wireless communication device. [*See, e.g.,* Application, p. 23, lines 1-22]

4. ISSUES

Issue 1

Whether claims 1-9, 11-17, 19, and 21-27 are unpatentable under 35 USC §103(a) over Altschul et al. (US 5,983,094) in view of Goldhaber et al. (US 5,855,008) further in view of Titmuss et al. (WO 98/47295).

5. ARGUMENT

(i) *Rejections under 35 USC §103(a):*

Claims 1-9, 11-17, 19 and 21-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Altschul et al. (5,983,094 hereinafter Altschul) in view of Goldhaber et al. (5,855,008 hereinafter Goldhaber) further in view of Titmuss et al. (WO 98/47295

hereinafter Titmuss). Claims 1, 13 and 27 are independent claims. Claims 2-9, 11, 12, 21 and 22 depend from claim 1. Claims 14-17, 19, 23-26 depend from claim 13. The rejection of the foregoing claims is respectfully traversed for the following reasons.

There exists a significant distinction in the art between these prior art references and the presently claimed invention. Starting initially with Altschul, Altschul is directed to a wireless telephone that can also serve as a credit card. Altschul describes a business model in which "the amount of paid airtime available through a wireless telephone is increased selectively and, in particular, is increased in proportion to the purchase amounts of selected purchases of goods and services through a purchase account, such as a credit card account." [Altschul, Col. 1, lines 8-14] The patent repeatedly emphasizes that airtime is increased proportionally to the amount of credit card purchase. [*See, e.g.*, Altschul, Col. 1, lines 36-39 ("provides wireless telephone users with increased airtime in proportion to the use of purchase accounts, such as credit card accounts")] The purpose of the model is stated clearly in the patent: "the additional duration being in proportion to the purchase amounts made through the credit card account, thereby providing an incentive to use the credit card account identified in a magnetic strip 262 of the telephone 210." [Altschul, Col. 6, lines 45-49] Thus, Altschul teaches a method directed to increasing the use of credit card purchases by providing an additional and proportional amount of "free" air-time.

Moreover, this "free" air-time described in Altschul is provided completely ***independent*** of (and in addition to) the subscribed periods of airtime charged by the telephone subscription service. [Altschul, Abstract ("enables the purchase amounts to be converted to additional periods of airtime during which telephonic communications are enabled independent of the subscribed periods of airtime"); Col. 5, lines 64-67 ("such purchases is converted into additional periods of airtime during which telephonic communication is enabled, independent of subscribed periods of airtime charged by the telephone subscription service")]. Thus, the additional time is simply tacked on to existing subscription fees and calculated proportionally to provide a continued incentive to buy more products on the credit card account.

The model in Altschul is completely different from the one recited in the pending claims. First, Altschul does not teach or suggest providing any types of advertisements to the end user. In the final rejection, the Examiner stated "the end user can use the telephone (10) to make purchases or subscribe to services displayed on the display screen then some sort of advertising must exist in order to arouse a desire for the customer to buy or patronize a product." [Final Rejection, June 14, 2002, page 8] We are confused by this conclusion. There is a telephone (10) described in Altschul and it can be used to subscribe to services. However, the only display screen shown in Altschul is a "visual indicator 62" that is described as displaying "the amount of airtime available for use". There is also a "logo area 36" but this appears to be nothing more than a physical area on the phone to position logos or other information related the credit card company. The block diagrams in FIGS. 3 and 5 appear to confirm this since no display means other than the visual indicator (62) is shown.

In any event, the Examiner missed several points made by the Applicants in their last response. Although the Applicants appreciate the reminder that one cannot show nonobviousness by attaching references individually where the rejection is based on the combination of references, the final rejection failed to address or provide any guidance in response to several arguments already made on why Altschul should not and cannot be combined with the other references.

For instance, in our last response, the Applicants pointed out that even if one tried to add (or combine) the use of advertisements "in lieu of receiving compensation for the subscription," the whole purpose of Altschul is removed – providing a continued incentive to use a credit card account. [Altschul, Col. 6, lines 45-49 ("the additional duration being in proportion to the purchase amounts made through the credit card account, thereby providing an incentive to use the credit card account identified in a magnetic strip 262 of the telephone 210.")] Thus, the proposed combination in the final rejection would render Altschul unsatisfactory for its intended purpose. A proposed combination cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also In re Ratti*, 270 F.2d 810 (CCPA 1959)

(the proposed combination cannot change the principle operation of a reference). The Examiner did not respond to this point.

Moreover, the Applicants pointed out in our last response that Altschul actually teaches away from a combined method that adds advertisements ***in lieu*** of receiving compensation for the subscription. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the applicant. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). Altschul teaches that in exchange for credit card purchases, the model in Altschul provides users with increased airtime in proportion to the use of the credit card account. [Altschul, Col. 1, lines 36-39] The proportional amount of time added is done independent of subscribed periods of airtime charged by the telephone subscription service. [Altschul, Abstract and Col. 5, lines 64-67] Thus, Altschul teaches a continued incentive to use a credit card account by adding more time to an already existing service subscription and fee. Teaching away is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988). The Examiner did not respond to this point.

In addition to suggestions against combining the references, the Applicants pointed out that the deficiencies in Altschul are not contained in Goldhaber and Titmuss even if one could combine the references. For instance, Goldhaber is directed to distributing advertising and other information over a computer network. The system described in Goldhaber provides a computer user with an incentive to view advertisements by providing "a 'consumer interface button' – for example, the image of a little gold coin ('CyberCoin') next to each title on a list." [Goldhaber, Col. 5, lines 35-37, Fig. 11, Col. 16, lines 24-47] Selecting the associated CyberCoin icon initiates an interaction between the consumer's computer and an attention brokerage server storing the matching ad. [Goldhaber, Col. 16, lines 44-47] The patent states that the use of the consumer interface button – the "CyberCoin" – is innovative and unique in that it transfers real value to the computer user. [Goldhaber, Col. 5, lines 38-41] The patent further explains that this is a radical change in sponsorship in that "the advertisers have

elected to sponsor the consumer who selects the CyberCoin – that is, they have chosen to pay the consumer directly for her attention rather than using the same funds for mass-market ad campaigns." [Goldhaber, Col. 5, lines 42-47]

In Applicants' last response, we pointed out that the Examiner's reliance on Column 12, lines 5-14 and Col. 6, lines 20-27 of the Goldhaber reference to support the combination of the references was misplaced. These citations, in effect, really support an important distinction between the claimed invention and the Goldhaber reference. Column 12, lines 5-14 refers to Figure 6 in Goldhaber where it states that advertisers (62) can directly compensate consumers (64) via payment (60(a)) for viewing and paying attention to their advertisements (68). It goes on to say that consumers (64) can use this payment (60(a)) to compensate information provider (6) via ***another payment 60(b)*** for providing entertainment or other information (70) the consumer wishes to access. The next sentence becomes important and highlights that Goldhaber requires a second payment – "[s]ponsorship becomes ***unlinked*** from the content of the sponsored entertainment or service 70, much to the benefit of the consumer." [Goldhaber, Col. 12, lines 12-14 (emphasis added)] Thus, Goldhaber teaches a ***direct*** payment to the computer user that is ***unlinked*** to the service provider. In contrast, the invention in claims 1 and 13 include the step of providing advertisements to the end user (in a wireless communication network) ***in lieu of*** receiving compensation for the subscription. Accordingly, the advertisements and the compensation of the subscription ***are linked*** in the claims. This is important because the present invention teaches a system or method that avoids a secondary payment being made by the user back to the service provider. Instead of a user having to make a secondary payment to pay down or reduce an existing subscription fee, the present invention allows service operators to provide service options to individuals who might not ordinarily be able to afford typical subscription fees. The Examiner did not respond to this point either in the final rejection.

Titmuss describes a method of delivering information to mobile users in a telecommunication system. Titmuss does discuss the transfer of information based on the format type supported by a terminal. Titmuss, however, does not make up the

deficiencies in Altschul and Goldhaber. For example, Titmuss has no description or suggestion of a system or method that provides ***advertisements*** to an end user ***in lieu of*** receiving compensation for the subscription. Titmuss is silent as to advertisements and how they could be provided to an end user in relation to compensation for subscription fees. In fact, it appears that Titmuss teaches that a fee is imposed for the system. [Titmuss, Page 21, lines 12-13 ("Each personal agent may periodically report use of the services available to a billing system for billing purposes.")] Titmuss appears to be related to a much more complex system where a user has access to many types of terminals and the ability of the user to select or access information from those terminals depending on the file type.

With regard to independent claim 27, the final rejection does not specifically address the added limitations in claim 27 but simply refers to the discussion relating to claims 12 and 13. Claim 27, however, recites that the step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references (Altschul, Goldhaber or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors. It does not appear that the final rejection addresses this point.

In sum, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In other words, the prior art references (separately ***and in combination***) fail to teach or suggest all of Appellants' claimed limitations, as required for a 35 USC §103(a) rejection. MPEP706.02(j). Namely, as claimed, none of the references teaches at least the step of providing advertisements to the end user (in a wireless communication network) ***in lieu of*** receiving compensation for the subscription. Additionally, with respect to independent claim 27, none of the references teaches the additional step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device.

The failure of these references to teach all the claim limitations is the reason why the Applicants have addressed each reference individually. Moreover, as discussed above, even if the cited references in the final rejection could be combined, the proposed combination would render at least Altschul unsatisfactory for its intended purpose and would change the principle operation of that reference. Thus, these references clearly fail, alone or in combination, to anticipate or render obvious the claims.

Claims 2-9, 11, 12, 21, 22 depend on independent claim 1. Claims 14-17, 19, 23-26 depend on independent claim 13. These dependent claims are believed to be allowable for at least the same reasons discussed above. *See In re Fine*, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.). Some of these dependent claims are further discussed below.

With regard to claim 12, the final rejection (and the original office action) do not specifically address the added limitations in claim 12. Claim 12 depends on claim 1, and recites that the step of providing advertisements further includes providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. None of the cited references (Altschul, Goldhaber or Titmuss) discuss or make any mention of vehicle sensors much less advertisements based upon such vehicle sensors.

Claims 9 and 17 depends on claims 1 and 13, respectively, and recite that the step of providing advertisements further includes providing advertisements based upon advertisement acceptance. This is shown and described in the application with relation to Figure 7 where advertisement acceptance (558) is fed into an information pool so that the claimed method can provide advertisements based on such information. The final rejection (and the original office action) cite a general knowledge in marketing and advertisement fields but fails to provide this specific feature in the wireless communication network as taught and claimed in the present application. Deficiencies of the cited references (Altschul, Goldhaber or Titmuss) cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In*

re Zurko, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art).

The Applicants appreciate the legal standards recited in the final rejection regarding claims 9 and 17 about what a reference may or may not suggest to one of ordinary skill in the art. However, it is respectfully submitted that the final rejection (and the original office action) simply fails to establish a *prima facie* case of obviousness with regard to the claimed subject matter. The alleged "motivation" or "suggestion" provided by the examiner is not motivation or suggestion at all, as required by 35 USC 103, but merely a reason fabricated by impermissible hindsight gleaned from a knowledge of Applicants' disclosed invention.

Claims 6 and 14 depend on claims 1 and 13, respectively, and recite that the method include a further step of requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service. The final rejection cites the Goldhaber reference. Goldhaber is distinguishable for the reasons set forth above. In particular, claims 1 and 13 (and reiterated in claims 6 and 14) require that the method include providing advertisements to the end user ***in lieu of*** receiving compensation for the subscription. As described above, Goldhaber does not deal with wireless communication but teaches a ***direct*** payment to a computer user that is ***unlinked*** to the service provider. [Goldhaber, Col. 12, lines 11-14] In contrast, here, the claimed invention includes the steps of providing advertisements to the end user (in a wireless communication network) ***in lieu of*** receiving compensation for the subscription and requiring user interaction before being considered an advertisement that was provided ***in lieu of*** receiving compensation for the subscription. Accordingly, the advertisements and the compensation of the subscription ***are linked***. This is important because the present invention teaches a system or method that avoids a secondary payment being made by the user back to the service provider. Instead of a user having to make a secondary payment to pay down or reduce an existing subscription fee, the claimed invention allows service

operators to provide service options to individuals who might not ordinarily be able to afford typical subscription fees.

Claims 7 and 15 depend on claims 1 and 13, respectively. Claims 8 and 16 depend on claims 1 and 13, respectively. These claims recite that the step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list and providing advertisements based upon a shopping history of the end user. The final rejection (and office action) cites U.S. Patent No. 6,026,375 ("Hall") for the proposition that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to include these features. Hall is directed to a method and system for processing orders from customers in a mobile environment. The customer initiates the order. [Hall, Col. 8, lines 47-50] Hall does not teach providing advertisements much less how to provide such advertisements in lieu of receiving compensation for a subscription for a wireless communication device. In Hall, a user places an order and the order is filled by checking local establishments.

At the end of the final rejection, the Examiner appears to indicate that the Hall reference was in error when actually, it was meant to point out pages 14 and 19 of the Titmuss' reference. A review of these pages in Titmuss appears to generally mention a "personal agent" that has fields that store data such as a user's preference data. However, the reference did not teach the use of data as claimed in the pending claims. In particular, the reference does not appear to mention providing advertisements when a vendor has a product on an end user's shopping list. The reference also did not appear to mention the storage of a shopping history or providing advertisements based upon a shopping history of the end user.

Claims 11 and 19 depend on claims 1 and 13, respectively, and recite that the step of providing advertisements further includes providing advertisements at predetermined times based upon user device habits. The final rejection (and the prior office action) states that the combination of Altschul and Titmuss teaches that the personal agent accesses a customer database and retrieves information about customer's preferences to enable the system to provide advertisements based on the customer's preferences. It is

from this that the final rejection concludes that it would have been obvious to include in user's preference data a predetermined time when it would be convenient to receive advertisements based on user's habits. First, as explained above, the combination of Altschul and Titmuss to make the present invention would render Altschul unsatisfactory for its intended purpose and would change the principle operation of that reference. Second, although Titmuss discusses a database, Titmuss does not teach how this applies to sending advertisements over a wireless communication network. The page in Titmuss cited in the final rejection (page 19) discusses a personal agent that checks whether the summary of the information source contents corresponds with any of the users preferences. The suggested user preferences are listed on page 14 of Titmuss. None of the suggested user preferences talks about the willingness to accept advertisements or providing such advertisements at predetermined times based upon user device habits.

The Applicants respectfully request withdrawal of the obviousness rejection based on these references.

(ii) *Information Disclosure Statement*

The final rejection stated that an information disclosure statement filed on February 5, 2002 failed to comply with 37 CFR 1.98(a)(2). It is unclear to the undersigned attorney what statement, or portion thereof, failed to comply with 37 CFR 1.98(a)(2). According to our records, the Applicants filed a supplemental information disclosure statement on January 2, 2002 and it appears that the Examiner considered the information in that statement. We have no record of an information disclosure statement filed on February 5, 2002. Further clarification on what may not have considered by the Examiner would be appreciated.

CONCLUSION

For the above reasons, it is respectfully submitted that the Examiner reconsider the rejection of Claims 1-9, 11-17, 19, and 21-27 under 35 USC §103(a) as being unpatentable over Altschul et al. in view of Goldhaber et al. further in view of Titmuss, and the claims be allowed. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this reply, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter. Furthermore, please charge any additional fees (including extension of time fees), if any are due, or credit overpayment to Deposit Account No. 13-4772.

Respectfully Submitted,
STEELE ET AL.

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APPENDIX A

Appeal Brief: S/N 09/414,121
Application Filed: 08 October 1999

1. A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; and

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a content that a user is receiving on said wireless communication device.

2. The method of claim 1 wherein said plurality of service options includes location based services.

3. The method of claim 1 wherein the advertisements are based upon location related information of said wireless communication device, said location related information includes at least one of the following:

position, direction, or speed.

4. The method of claim 1 wherein said step of providing advertisements comprises providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of said predetermined vendor.

5. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements when end user preferences corresponds with vendor criteria.

6. The method of claim 1 further including a step requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service.

7. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list.

8. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements based upon a shopping history of said end user.

9. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements based upon advertisement acceptance.

11. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements at predetermined times based upon user device habits.

12. The method of claim 1 wherein said step of providing advertisements comprises providing advertisements based upon the status of sensors in a vehicle incorporating said wireless communication device.

13. A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; and

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device.

14. The method of claim 13 further including a step requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service.

15. The method of claim 13 wherein said step of providing advertisements comprises providing advertisements when a vendor has a product on an end user's shopping list.

16. The method of claim 15 wherein said step of providing advertisements comprises providing advertisements based upon a shopping history of said end user.

17. The method of claim 13 wherein said step of providing advertisements comprises providing advertisements based upon advertisement acceptance.

19. The method of claim 13 wherein said step of providing advertisements comprises providing advertisements at predetermined times based upon user device habits.

21. The method of claim 1, further comprising a step of determining a location of said wireless communication device and wherein the provision of the advertisements is further based upon the determined location of said wireless communication device.

22. The method of claim 21, further comprising a step of conveying the determined location of said wireless communication device to a provider of at least one of said products or services.

23. The method of claim 13, wherein the configuration of said wireless communication device comprises a wireless data transmission protocol supported by said wireless communication device.

24. The method of claim 13, wherein the configuration of said wireless communication device comprises a file type that can be displayed by said wireless communication device.

25. The method of claim 13, further comprising a step of determining a location of said wireless communication device and wherein the provision of the advertisements is further based upon the determined location of said wireless communication device.

26. The method of claim 25, further comprising a step of conveying the determined location of said wireless communication device to a provider of at least one of said products or services.

27. A method of providing service in a wireless communication network comprising the steps of:

providing a plurality of service options to an end user of a wireless communication device in a vehicle operating on said wireless communication network;

providing products or services to said end user in response to a subscription to one of said service options; and

providing advertisements to the end user in lieu of receiving compensation for the subscription, wherein the provision of the advertisements is based upon a configuration of said wireless communication device and the advertisements are based upon a status of sensors in the vehicle incorporating said wireless communication device.